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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,229	10/31/2003	Peter Thurmann	5253-27	3382
27799	7590	03/02/2006		EXAMINER
COHEN, PONTANI, LIEBERMAN & PAVANE			SCHWARTZ, CHRISTOPHER P	
551 FIFTH AVENUE				
SUITE 1210			ART UNIT	PAPER NUMBER
NEW YORK, NY 10176				3683
				DATE MAILED: 03/02/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/699,229

MAR 02 2006

Filing Date: October 31, 2003

Appellant(s): THURMANN ET AL.

GROUP 3600

Thomas C. Pontani
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the remand by the Board of Appeals of February 23, 2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that

there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The statement of the summary of claimed subject matter is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The Brief contains a concise statement for the ground(s) of rejection presented for review.

(7) *Argument*

The Brief contains an argument with respect to each ground of rejection presented for review.

(8) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

4,281,884 Freitag et al. 08-1981

5,791,445 Kaufmann et al. 08-1998

(10) Related Proceedings Appendix

The Brief contains a Related Proceedings Appendix but with a statement that there or no related proceedings.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-7,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freitag et al. in view of Kaufmann et al.

Regarding claim 1 Freitag et al. discloses a piston cylinder unit having a heat shrunk sleeve 10 surrounding a cylinder, as clearly shown in the several embodiments. Note also element 36 which extends into the gap. Note the end wall and gap (not labeled) but as per applicant's.

Freitag et al. however lacks showing the sleeve 10 "enclosing" the end face (in the area of element 4) and extending into the gap.

Kaufmann et al. provides this general teaching.

One having ordinary skill in the art at the time of the invention would have found it obvious to have extended the sleeve 10 of Freitag et al. into the gap (not labeled but above element 4 between the rod and the tube) to further seal the rod from the environment or act as a "wiper" (as is notoriously well known in the art) for the rod to remove debris. Elements 10 and 36 could be made integral, as fairly suggested by Kaufmann et al.

Regarding claims 3-4 these requirements are met. The end ring is at 4 in Freitag et al.

Regarding claim 5 the end ring 4 has an "annular channel" through which the piston rod extends and can be said to "face" the ring shaped gap above it, as broadly claimed.

Regarding claim 6 these requirements are met.

Regarding claim 7 the element below element 4 in Freitag et al. could also be interpreted as the end ring, which also comprises an annular channel which meets or renders obvious the limitations of claim 7 in that the width of the channel is not limited.

Regarding claim 13, as broadly claimed, these requirements are met.

Allowable Subject Matter

4. Claims 8-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 14-21 are allowable over the prior art of record.

(12) Response to Arguments

Appellant's arguments have been fully considered but are not persuasive.

Applicant's cited case law to *In re Fine*, *In re Jones*, *In re Gordon* and *In re Ratti*, have been noted.

Appellant's seem to have attempted to make the combination of Freitag et al. as modified by Kaufmann et al. more complicated than it is.

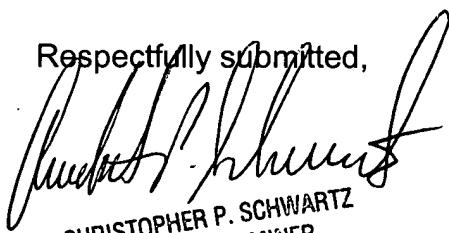
Freitag et al. shows a pneumatic spring having an insulating sleeve at 10 and a similar sleeve at 36 which extends into the gap (not labelled) but above element numeral 4. As stated in Freitag et al. col 3 lines 20-22 the sleeve 10 can be a shrunk plastic tube.

The reference to Kaufmann et al. shows a similar device to that of Freitag et al. Please note the title of the invention which states "Piston rod cylinder assembly with shrink wrap corrosion protective sleeve. At col. 2 Kaufmann et al. states "...the shrink wrap sleeve has a cylindrical segment 24 that wraps around an axial portion of the piston rod 14 forming a seal which effectively prevents moisture or other contaminants from penetrating along the rod to the cylinder 12..."

As stated in applicant's citations to *In re Fine* and *In re Jones* "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art..." See MPEP 2144 p. 2100-134. Because there is a reasonable expectation of success (*In re Merck & Co. Inc.*, 800 F.2d 1091) in making the plural sleeves 10 and 36 of Freitag et al. integral, (as notoriously well known in the art—See *In re Larson*) as suggested by Kaufmann et al., and extending into the gap for the expected benefit of sealing the inside of the device from the environment, the proposed rejection is maintained to be proper.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

cps
February 28, 2006

Conferees
mcg mcc
rs DS
db DB

COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176